

REMARKS

The foregoing amendment and the following arguments are provided generally to impart precision to the claims, by more particularly pointing out the invention, rather than to avoid prior art.

Claims 10-13, 15, 16, 32-36 and 38 are pending in this application. Claims 10-13, 15, 16 and 32-36 and 38 have been rejected. In this response, claims 10, 12, 13, 32, 33, 35, 36, and 38 have been amended. Claims 39-44 have been newly added. No new matter has been added. Reconsideration and withdrawal of the rejections set forth in the Office Action dated May 23, 2008, are respectfully requested in view of the remarks below.

Interview Summary Statement

A telephonic interview was conducted between Examiner Adnan M. Mirza and applicant's representative, Yenyun Fu. The undersigned representative wishes to thank Examiner Mirza for the telephonic interview conducted on July 22, 2008. During the interview, independent claims 10, 38, and reference Roberts, et al. (U.S. Pat. No. 6,101,486) were discussed.

Applicant herein submits the amendments based on the discussion with the Examiner. No particular agreement was reached during this interview.

35 U.S.C. § 103 Rejections

Claims 10-13, 15, 16, 32-36 and 38

The Examiner has rejected claims 10-13, 15, 16, 32-36 and 38 under 35 U.S.C. §103(a) as being allegedly unpatentable over Roberts, et al. (US 6,101,486) in view of Gilmour, et al. (US 6,421,669). Applicant respectfully disagrees.

I. The cited references do not disclose all the subject matter in the independent claims 10, 34, and 38

Applicant respectfully submits that when viewed individually or as a whole, the cited references do not show the subject matter recited in the pending claims.

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).”

Applicant respectfully submits that the combination of Roberts and Gilmour do not render obvious applicants independent claims since, they do not disclose each and every element of independent claims 10, 34, and 38, either individually or in combination, as explained below.

Neither Roberts nor Gilmour discloses, per claim 10, "receiving a request from a first user to add contact information of a second user to the electronic phonebook of the first user ... and adding the contact information of the second user to the electronic phonebook of the first user ..."

Reference 'Roberts'

The Examiner acknowledges that (Page 2 of Office action mailed May 23, 2008) Roberts does not disclose "determining if the request includes a cookie that is associated with the first user profile [;] adding the data set of the second user profile to the first user profile in response to determining that the request includes a cookie that is associated with the first user profile."

The Examiner, however, states that (Page 2 of Office action mailed May 23, 2008) that Roberts disclosed "a method of receiving request from a first user to add a data set of a second user profile ... wherein the URL includes a unique identifier for identifying the second user profile; identifying the data set from the second user profile based on the unique identifier (Roberts, col. 5, lines 15-25)." Applicant respectfully disagrees.

Applicant further submits that Roberts also does not teach or suggest at least the following emphasized subject matter, some of which have been newly added to independent claim 10.

1. The cited references do not show "receiving a request from a first user to add contact information of a second user to the electronic phonebook of the first user" (Claim 10)

2. The cited references do not show "the request is detected when the first user accesses a URL provided by the second user to the first user" (Claim 10)

3. The cited references do not show "adding the contact information of the second user to the electronic phonebook of the first user..." (Claim 10)

Although Roberts describes "a method and system for gathering and storing customer profile data when the customer accesses a website location (Roberts, abstract)", Roberts does not discuss or teach "receiving a request from a first user to add contact information of a second user to the electronic phonebook of the first user " where "the request is detected when the first user accesses a URL provided by the second user to the first user", as claimed in independent claim 10.

For example, in Roberts:

"Systems and methods consistent with this invention accomplish these goals and provide other advantages by automatically collecting customer profile information when the customer accesses a company's website." (Col. 2, lines 31-38)

Therefore, in Roberts, when a customer contacts (i.e., visits or accesses) the company web site, the customer profile of the customer is collected. The method of Roberts of "collecting customer profile information when the customer accesses a company's website" is contrastingly **different from and unrelated to** "receiving a request from a first user to add contact information of a second user to the electronic phonebook of the first user" where "the request is detected when the first user accesses a URL provided by the second user to the first user", as claimed by applicant in independent claim 10.

Applicant submits that the statements made by the Examiner in the Office action mailed on May 23, 2008 are not supported by Roberts. In order to establish Roberts as a proper prior art reference, the Examiner relies on the description in Col. 5 lines 15-25 of Roberts:

"When a customer accesses a company's website via network 140 to research a product or service purchase, information identifying the particular customer and the product desired is gathered by NSP apparatus 130. As shown in FIG. 2, the collection of customer profile information may be accomplished through a number of customer initiated input operations. Keyboard entries to pull down menus and text fields, as well as mouse clicks of multiple choice check boxes or banner selections are examples of the type of customer input operations used to supply the identification information. ... " (Col. 5, lines 5-15)

Though the user profile of a user is retrieved and collected when the customer accesses a company's website, there is no indication of "receiving a request from a first user to add contact information of a second user to the electronic phonebook of the first user" where "the request is detected when the first user accesses a URL provided by the second user to the first user" and "adding the contact information of the second user to the electronic phonebook of the first user...", as claimed by applicant in independent claim 10.

The statement made by the Examiner on Page 2 of the Office Action mailed May 23, 2008, Page 3 is unsupported by Roberts and thus applicant submits that Roberts is not a proper prior art reference, in particular, in light of the amended independent claim 10.

Furthermore, applicant's independent claim 10 includes the subject matter of "the URL includes a unique identifier to for identifying the contact information of the second user". When viewed as a whole, the cited references do not show "the URL includes a unique identifier for identifying the contact information of the second user".

For example, in Roberts,

"When the customer contacts (i.e., visits or accesses) the company website (Step 410), the customer profile is retrieved from profile database 170 by AC device 155 (Step 420) ... retrieving

various dynamic content messages and displaying them on customer terminal 110 when the customer is viewing the company's website."(Col. 6, lines 21-23)

Thus, the website or URL of Roberts is associated with a company webpage. The company's URL (webpage), when accessed by a customer, causes the customer profile of the customer to be retrieved. Thus, the company URL as described by Roberts does not involve another user, and, as such, does not include "a unique identifier for identifying the contact information of the second user". Thus, applicant respectfully submits that Roberts does not motivate, teach, or suggest a URL "a unique identifier for identifying the contact information of the second user" as claimed by applicant in independent claim 10.

4. Roberts Teaches Away

In fact, applicant respectfully submits that Roberts teaches away from the claimed subject matter of "receiving a request from a first user to add contact information of a second user to the electronic phonebook of the first user" where "the request is detected when the first user accesses a URL provided by the second user to the first user" and "adding the contact information of the second user to the electronic phonebook of the first user" since in Roberts, the user information of the customer who accesses the URL is obtained by a website, which is the opposite of obtaining another user's (the second user') information when the first user accesses a URL.

Accordingly, applicant submits that Roberts teaches away from the claimed subject matter of "receiving a request to add a data set of a second user profile to a first user profile from a first user" where "the request is detected when the first user accesses a URL provided by the second user to the first user", as claimed by applicant in independent claim 10. Therefore, applicant respectfully submits that the claimed subject matter of independent claim 10 is not obvious over Roberts, and/or the additional art.

Reference 'Gilmour'

Gilmour was cited for alternate subject matter recited in the previously pending claims and does not cure the deficiency of Roberts.

Specifically, Gilmour describes a method of constructing an entity profile, having private and public portions with different access restrictions (Abstract). Gilmour, however, does not include at least the recited subject matter of "receiving a request from a first user to add contact information of a second user to the electronic phonebook of the first user" where "the request is detected when the first user accesses a URL provided by the second user to the first user" and "adding the contact information of the second user to the electronic phonebook of the first user", in claim 19.

Thus, even if Roberts and Gilmour were combined, the resulting disclosure would be different from what is recited in claim 10. The combination would not include the claimed subject matter of, "receiving a request from a first user to add contact information of a second user to the electronic phonebook of the first user" where "the request is detected when the first user accesses a URL provided by the second user to the first user" and "adding the contact information of the second user to the electronic phonebook of the first user" as claimed by applicant.

Thus, without admitting to the propriety of combining Roberts and Gilmour in a way presented in the Office Action, applicant submits that independent claim 10 is patentable individually over Roberts, Gilmour, and over the combination of Roberts and Gilmour, at least for the above stated reasons.

Thus, at least for the above stated reasons, the withdrawal of the rejection under 35 U.S.C. §103(a) for independent claim 1 is respectfully requested. The withdrawal of the rejections under 35 U.S.C. §103(a) is also respectfully requested for independent claims 34 and 38 based on similar and/or same reasoning.

Dependent Claims

In view of the above remarks, a specific discussion of the dependent claims is considered to be unnecessary. Therefore, applicant's silence regarding any dependent claim is not to be interpreted as agreement with, or acquiescence to, the rejection of such claim or as waiving any argument regarding that claim. Therefore, the remaining dependent claims are also patentable over the cited references. The withdrawal of the rejections under 35 U.S.C. §103(a) is respectfully requested for claims 11-13, 15, 16, 32-33, and 35-36.

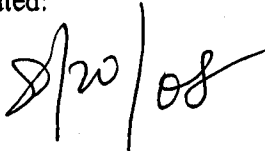
CONCLUSION

Applicants submit that the pending claims are now in condition for allowance. A Notice of Allowance is, therefore, respectfully requested.

The Examiner is authorized to charge any underpayments or credit any overpayments to our Deposit Account No. 50-3992, under Order No. 418268646US from which the undersigned is authorized to draw.

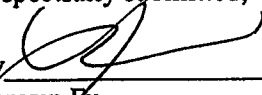
If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is encouraged to call the undersigned at (650) 838-4306.

Dated:



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Respectfully submitted,

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